

**REMARKS**

At the outset, the Examiner is thanked for the thorough review and consideration of the pending application. The Office Action dated June 14, 2005 has been received and its contents carefully reviewed.

In the Office Action, claims 11-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,627,470, issued to Yoo et al. (hereafter "Yoo"). Applicant respectfully disagrees with the Examiner's assessment that the claims of the present application are not patentably distinct from claim 4 of Yoo. Specifically, Yoo discloses "performing a back exposure to form a pixel electrode" and "the pixel electrode overlaps the PAI pattern" (see, claims 1 and 4). However, Yoo fails to teach or suggest "forming a protection layer on the thin film transistor and on the gate insulation layer, wherein forming the protection layer includes etching the protection layer to cover the first side but not the second side of the drain electrode" as recited in independent claim 11 of the present application. Accordingly, independent claim 11 and its dependent claims 12-21 are patentably distinct from Yoo. However, to expedite prosecution of the case, Applicant files a terminal disclaimer to overcome the double-patenting rejection. Withdrawal of the rejection is respectfully requested.

In the Office Action, claims 11-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,104,042, issued to Sah (hereafter "Sah") in view of U.S. Patent No. 5,920,082, issued to Kitazawa et al. (hereafter "Kitazawa"). Applicants respectfully traverse the rejection below.

The Office Action concedes on page 4 that Sah does not teach "forming the pixel electrode by using a back exposure". To remedy this deficient teaching of Sah, the Office Action relies upon the teachings of Kitazawa. Based upon the teachings of Kitazawa, the Office Action concludes that it would have been obvious to one skilled in the art at the time the invention was made to modify Sah, using the teachings of Kitazawa, to obtain the combined features recited in the claims of the present application. Applicants respectfully submit there is not proper motivation to combine Sah and Kitazawa.

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Also, there must be a reasonable expectation of success. Applicant respectfully submits the teachings of Sah are directed to improved performance of BCE and ES TFT (see, col. 2, lines 1-41). However, there is no teaching which would provide motivation to one of ordinary skill in the art to modify the teachings of Sah by the back exposure method of Kitazawa to obtain all the features recited in the claims of the present application. Additionally, even if the back exposure method of Kitazawa were used to modify Sah, which Applicant does not concede there is proper motivation to do, one of ordinary skill would recognize the pixel electrode 54 (FIGs. 8C and 8D) of Sah can not be formed over the reference number 42a. More specifically, Applicant submits this combination of Sah and Kitazawa would cause the pixel electrode to have an unexpected defect resulting in a lack of reasonable expectation of success for combining the two references as suggested in the Office Action.

Based upon the above discussion, one of ordinary skill in the art would not be motivated to combine the teachings of Sah and Kitazawa to successfully obtain the combined features recited in the claims of the present application. Accordingly, claim 11 and its dependent claims 12-15 are patentable over any combination of Sah and Kitazawa. Reconsideration and withdrawal of the rejection.

In the Office Action, claims 16-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sah, Kitazawa and further in view of Applicant's admitted prior art (APA), figures 2 and 4. Claims 16-21 depend from independent claim 11. By virtue of their dependence from independent claim 11, claims 16-21 are allowable over Sah and Kitazawa for at least the reasons discussed above with regard to claims 11-15. Further, APA fails to remedy the deficient teachings of Sah and Kitazawa. As such, claim 11 and its dependent claims 16-21 are allowable over any combination of Sah, Kitazawa and APA. Reconsideration and withdrawal of the rejection are respectfully requested.

Applicants believe the foregoing amendments place the application in condition for allowance and early, favorable action is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

By Valerie P. Hayes  
Valerie P. Hayes  
Registration No.: 53,005  
McKENNA LONG & ALDRIDGE LLP  
1900 K Street, N.W.  
Washington, DC 20006  
(202) 496-7500  
Attorneys for Applicant